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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,785	02/16/2001	Leon P. Janik	STAN/322/US	3391

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EXAMINER

CECIL, TERRY K

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/785,785	JANIK ET AL.
Examiner	Art Unit	
Mr. Terry K. Cecil	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 June 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC '102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Janik et al. (U.S. 5,484,527), hereinafter “Janik”. Janik discloses a method for manufacturing a base module for a filter cartridge wherein the base module has inlet and outlet fittings defining fluid passageways oriented at first and second angular positions relative to each other (in this case the fittings are 360° apart, as shown in figure 6) and including the steps of :

- providing a communication module having inlet and outlet fittings: custom member 18 includes fittings 27 and 33;
- providing a body *adapted* to receive and mate with said communication module in a plurality of angular orientations to said communication module: the locating ring 30 of generic member 20 can mate with the annular opening of custom member 18 in a plurality of angular orientations;
- mating said communication module at a selected angular orientation selected from said plurality of angular orientations and joining together the module and body at the selected angular orientation: the orientation shown in the drawings is taken as being the selected orientation [as in claim 21].

Janik also discloses the following steps:

- providing inlet and outlet fittings that are integral to said communication module and have a fixed angular orientation thereto [as in claim 27]; and
- providing inlet and outlet fittings that are not coaxial with the axis of the communication module: fittings 27 and 33 are not coaxial with the axis defined by conduit 24 of member 18 [as in claim 28].

Claim Rejections - 35 USC ' 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.
Ascertaining the differences between the prior art and the claims at issue.
Resolving the level of ordinary skill in the pertinent art.
Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Janik. Claim 23 has the limitation of the step joining members 18 and 20 to comprise ultrasonic welding. Janik teaches his members 18 and 20 to be joined together e.g. by screws and for polymeric members

18 and 50 to be joined together by *sonic*¹ welding. Since member 20 can also be made of polymeric material (col. 1, lines 52-54) and since Janik teaches that various modifications, adaptations and alternatives that may occur to one skilled in art can be made without departing from the spirit and scope of his invention (col. 4, lines 60-63), it would have been obvious to the skilled man at the time of the invention for the joining step of members 18 and 20 to be accomplished by ultrasonic welding, since Janik teaches the benefit of a "fluid tight connection" (col. 3, lines 14-17) and that the ultrasonic weld of 18 and 50 mentioned above would be an obvious alternative to the screws 40 to also fasten 18 and 20.

5. Claim 22 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janik, as applied to claim 21 above and in further view of Schmidt (U.S. 4,452,695). Janik has been expanded above and teaches a communication module having integral, axially-extending² inlet and outlet connectors but does not teach separate inlet and outlet fittings.

However, Schmidt teaches separate inlet and outlet fittings 60 (shown in figure 3) that are mounted to and threadingly joined to threaded connectors 58 (shown in figure 1). Because of the threaded arrangement and additionally because the fittings are pivotable, the fittings can be mounted at any of a plurality of angular orientations to the communication module and can be angled differently from each other (as shown in figure 1)[as in claims 22 and 24]. Schmidt also

¹ One skilled in the art would realize that the amount of sound energy necessary to weld the polymeric materials cited by Janik (in col. 3, lines 48-49) would be in the *ultrasonic* range.

² Janik's inlet and outlet fittings 27, 33 are considered to be axially-extending since they are respectively coaxially-extending with the axes defined by inlet and outlet passageways 34 and 82 as shown in figure 6. Applicant has not defined any other axis in claim 22 nor its parent claim.

teaches mounting a sealing ring 83 between the fittings and the threaded connectors 58 [as in claim 25). It is considered that it would have been obvious to one of ordinarily skilled in the art at the time of the invention to have the fittings 60 of Schmidt in the invention Janik, since Schmidt teaches the benefits of ease of installation and pivoting of the hoses 42 as is necessary for that installation (col. 4, lines 51-53).

As for claim 26, it was explained in section 5 above, that it would have been within ordinary skill to substitute the threaded arrangement of Janik with a sonic weld for combining the communication module to the body. The examiner contends that such a modification to connect fitting part 82 to the connector 58 would also be within ordinary skill for the same reasons as above—including, e.g. to make a “fluid tight connection”.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janik in view of Le Clair. As explained in section 2 above, Janik teaches a body joined to a communication module. As shown in e.g. figure 3, the round locating ring of the communication module is received in the round aperture of the coupling plate of the body. The communication module and the body are then joined by fastening means (see claim 5 of the reference). The angular orientation shown in the drawings of the joined parts is taken as being the “selected” angular orientation as claimed. Additionally, it is pointed out that Janik teaches a body 12 including a mounting bracket 20 and a skirt (annular locating ring 30) [as in claims 1 and 2]. Janik does not teach the body to include a lip extending coaxially with the central opening thereof and mating with the skirt. Le Clair teaches a body 2 having a lip (the vertical portion between the leaders of

reference nos. 5 and 6) that extends away from the receptacle for mating closely with a vertical portion (skirt) of the communication module 7 [as in claims 1-3]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the body of Janik to include the lip of Le Clair for mating with the skirt of Janik, since Le Clair teaches the benefit of a configuration for mating/locating a body to a communication module (e.g. by screws/locating ring, as desired by Janik) in an apparatus for use in the same environment as Janik—filtration of fuel.

As for claim 10, members 12 and 18 are separately molded.

As for claim 4, both Janik and Le Clair teach rubber o-rings (grommets) positioned in the joint between elements: e.g. “109” in Janik and 25 and in Le Clair. It is considered within ordinary skill to have an o-ring in the joint between members (e.g. the lip and skirt) in order to effect a fluid tight seal.

As for claim 5, having an ultrasonic weld between the communication module and body is within ordinary skill (see section 5 above).

As for claims 6 and 7, the fittings of Janik are perpendicular to the axis defined by the module.

As for claims 8 and 9, Janik teaches fittings 27 and 33 can be located at different locations on member 18 depending upon the particular design requirements and constraints of each type of

vehicle (col. 3, lines 28-30). Therefore, positioning the fittings 90° apart or 180° apart (e.g. as shown in Le Clair) is a matter of optimization and within ordinary skill.

7. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janik in view of Schmidt. Janik has been expanded above and teaches a joined communication module and body, wherein as shown in e.g. figure 3, the round locating ring of the communication module is received in the round aperture of the coupling plate of the body. The communication module and the body are then joined by fastening means (see claim 5 of the reference). The angular orientation shown in the drawings of the joined parts is taken as being the “selected” angular orientation as claimed. The communication module includes axial inlet and outlet conduits and extending connectors 27 and 33 and mounting bracket 20 extending from the body [as in claim 11]. Janik doesn’t teach connectors extending axially away from the receptacle [as in claim 11] nor fittings connected thereto in a plurality (or infinite) angular orientations. Schmidt teaches connectors 58 positioned on a top side of a filter head 44 extending axially from the receptacle [as in claim 11] and including pivotable fittings 60 [as in claim 12]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the connectors 27 and 33 to be on the top side of member 18 and to include the pivotable fittings 60 of Schmidt since Schmidt teaches the benefits of ease of installation and pivoting of the hoses 42 as is necessary for that installation (col. 4, lines 51-53) and since Janik teaches that his fittings can be located at different locations on member 18 depending upon the particular design requirements and constraints of each type of vehicle (col. 3, lines 28-30).

As for claims 13 and 14, joining the communication module and the base or the connectors with the fittings with an ultrasonic weld is within ordinary skill, as explained above in the rejection of claim 26.

As for claims 15 and 16, the fittings of Schmidt are L-shape and include axes that are non-coaxial.

As for claim 17, the angles orientation of the fittings are within ordinary skill as explained above in the rejection of claim 8.

As for claim 18, Janik teaches enlarged connector throats that would receive the fittings of Schmidt therein. However, alternately configuring the fittings to have the enlarged throats and the connectors to fit therein would be considered an obvious design modification within ordinary skill and insufficient for patentability of the invention.

As for claim 19, adding an o-ring to provide a fluid-tight seal between members is within ordinary skill, as explained above in the rejection to claim 25.

As for claim 20, the members are separately molded.

Response to Arguments

8. Applicant's arguments filed 6-12-2003 have been fully considered but they are not persuasive because of the following reasons:

- On page 7, applicant has argued that Janik does not teach a configuration wherein the body and the communication module can be joined together in more than one angular orientation because of his use of screws as a joining means. Firstly, the examiner points that the last three lines in each of applicant's apparatus claims 1 and 11 require only that the communication module be fixed to the body at a *single* angular orientation. Once fixed, the module and the body of applicant's assembly cannot be in more than one angular orientation from each other. In Janik, the angular orientation of the joined assembly shown in the drawings is considered by the examiner to be the claimed *selected* angular orientation. Secondly, as shown in figure 3, the screws would have the capability to join the members regardless of the angular orientation (the screws would be drilled through the coupling plate 36 of the body to join thereto the coupling plate 38 of the communication module 18). Thirdly, the joining means of Janik is not limited to screws: since his dependent claim 6 specifies the joining means to be screws, the joining means of the parent claims from which claim 6 depends would—as a legal necessity—be a broader interpretation of structural equivalence. For these reasons, the examiner contends that applicant has failed to show a *structural difference* between his *claimed* apparatus invention and that of the applied prior art.

- Applicant's arguments concerning Le Clair are irrelevant since the claimed "selected" angular orientation is taught in the primary reference of Janik and because the 102 rejection using Le Clair has been withdrawn. In the rejection of claim 1, Le Clair has been used only for his teaching of the body to include a lip extending coaxially with the central opening thereof to mate with a skirt.
- Concerning his method claims, applicant has argued (pages 8-9) that Janik does not teach steps (c) and (d) and therefore does not anticipate claim 21. Firstly, the examiner points out that since both the locating ring of the communication module and the aperture of the coupling plate of the body that receives the locating ring are round, the parts are adapted to meet at a plurality of angular orientations and therefore meet the limitation of step (b)—as also admitted by the applicant (page 7, lines 17-19). Secondly, the examiner points out that steps (c) and (d) require only that the module and the body be joined at a *single* angular orientation and that the angular orientation shown in the drawings of Janik is the claimed selected orientation such that Janik does anticipate claim 21.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (703)305-0079 for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:00a to 4:30p, on at least four days during the week M-F.
- The group receptionist can be reached at (703)308-0661 for inquiries of a general nature or those relating to the status of this or proceeding applications.
- Wanda Walker, the examiner's supervisor, can be reached at (703)308-0457 if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is 703-872-9306.



Mr. Terry K. Cecil
Examiner
Art Unit 1723

TKC
August 22, 2003